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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,864	08/28/2001	Sadao Fujii	089631-0112	1494

22428 7590 12/05/2003

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

HAMPTON HIGHTOWER, PATRICIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 12/05/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,864

Applicant(s)

FUJII ET AL.

Examiner

Patricia Hightower

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 116 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 14-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on August 13, 2003 has been entered.

35 USC §102 Rejection

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by JP 2000-080240 to TOSH CORP.

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JP 2000-080240 to TOSOH CORP discloses a transparent film that exhibits excellent optical properties, heat resistance, mechanical properties and surface smoothness by using a composition comprising a maleimide–olefin based polymer copolymer and a copolymer of specific composition. The film has a thickness of preferably 10-500 μm which is obtained by using a resin composition comprising (A) 1-99wt% of a maleimide–olefin copolymer with a number-average molecular weight of 1×10^3 to 5×10^6 composed of 40-60 mol% of constituent of formula I (R^1 is H or a 1-6 Carbon atom(s) alkyl) and 60-40 mol% of constituent of formula II (R^2 and R^3 are each H or a 1-6 Carbon atom(s) alkyl) and (B) 99-1 weight% of an acrylonitrile–styrene copolymer containing 21-45 weight % of acrylonitrile unit which anticipates the claimed transparent film. See English language abstract;

Although the reference is silent as to the claimed properties of the film such as retardation value, light transmission, haze, tear propagation strength, surface energy, etc; silence does not preclude the film of the reference from inherently possession said properties; since they are both of the same structural identity.

35 USC §102 Rejection

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 06-136058 TOSH CORP or JP 09-328523 to TOSH CORP.

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JP 06-136058 to TOSOH CORP discloses a thermoplastic resin composed of three specific kinds of constituent units, having a specific weight average molecular weight exhibiting low hygroscopicity and small dimensional change and having excellent transparency heat-resistance and mechanical strength wherein the thermoplastic resin is composed of (A) 20-80mol % of the constituent unit of formula I (R^1 is 1-18 Carbon atom(s) alkyl or 3-12 Carbon atom(s) Cycloalkyl), (B) 80-20mol% of the constituent unit of formula II (R^2 to R^4 are it or 1-8 Carbon atom(s) alkyl) and (C) 1-40 mol% of the constituent unit of formula III (R^5 is methyl; R^6 is 4-18 Carbon atom(s) alkyl or 3-12 Carbon atom(s) cycloalkyl) and has a weight-average molecular weight of 1×10^3 to 5×10^6 in terms of polystyrene; which anticipates the claimed invention. See English language abstract.

JP 09-328523 (TOSOH CORP) discloses a heat resistant film which exhibits excellent clarity, and adhesion to inorganic and organic compounds and has a low birefringence by forming it from a maleimide-olefin copolymer comprising 40-60mol% structural units represented by formula I (wherein R^1 is H or CH_3), 0-20 mol% structural units represented by formula II and 60-40 mol% structural units represented by formula III (wherein R^2 and R^3 are each R^1) and having a number average molecular weight of $1 \times 10^3 - 5 \times 10^6$, and is useful for an OHP sheet, and LCD backlight diffusion film, a capacitor film, a transparent conductive film. See English language abstract.

Claims 14-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

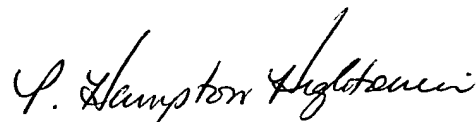
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Hightower whose telephone number is (703) 308-2434. The examiner can normally be reached on Monday-Friday from 9:30 a.m. to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

P. Hightower:lap
December 2, 2003

A handwritten signature in cursive script, reading "P. Hampton Hightower".

P. Hampton-Hightower
Primary Examiner
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